

Remarks

Applicant appreciates the Examiner's thorough examination of the subject application. Claims 1-20 are pending in the application and were rejected in the Office Action mailed 16 January 2009 on various statutory grounds, described in further detail below. Applicant respectfully requests reconsideration of the subject application in light of the following remarks.

Rejections under 35 U.S.C. § 103

A Claim is deemed obvious by the analysis set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). This analysis is as follows:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, longfelt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Id., at 17–18.

Claims

Claims 1, 3, 5 to 13, 15, and 17 to 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,065,778 to Terrell ("Terrell") in view of U.S. Patent. No. 4,020,856 to Masterson ("Masterson"). Applicant respectfully traverses these rejections and requests reconsideration of the above-identified Claims.

The Examiner asserts that all the elements of the above-identified Claims were disclosed by Terrell with the exception of the opening of the container located on a side wall. The Examiner has found that Masterson disclosed a fingernail and hand cleaning device having a container with a side wall having an opening for inserting the fingernail or hand to be cleansed.

Following *Graham*, which was reaffirmed in *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 398 (2007), the first step in an obviousness analysis is to determine the scope and content of the prior art. According to *KSR*, a claim “composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *Id.* at 401. “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements” in the way the claimed new invention does. *Id.*

The Applicant respectfully submits that Masterson’s mere description of a device with an opening does not qualify Masterson as a pertinent reference to be combined with Terrell. In fact, the devices of Terrell and Masterson are very dissimilar in their structure. It would not have been obvious to one of ordinary skill in the art to employ the opening of the hemispherical portion of the housing as described by Masterson into the device of Terrell because of these profound dissimilarities between the two devices.

The Examiner argues that Terrell and Masterson disclose a nail polish removing device having all the elements of the claimed invention. In particular, the Examiner alleges that Terrell discloses “a porous and pliable medium (43) at least partly above the solution compartment (see Fig. 2) *and in contact with the solution (when the container is inverted* col. 3, lines 33-38).” Office Action at 2 (emphasis added).

In the Applicant’s Remarks in her 23 July 2008 Response, the Applicant noted that, in conventional devices, the porous member was not in contact with the solution, but the solution was sprayed or otherwise delivered on the porous member. The Applicant submitted that, in the claimed invention, the porous and pliable medium is disposed in the container at least partly above the solution compartment and in contact with the solution so that, when the device is in use, the solution at least partly permeates the medium. The Examiner appears to have given

weight to this notion that the cited prior art did not teach or suggest a device in which the porous medium was in contact with the solution, since the Examiner has withdrawn the prior cited references. Instead, the Examiner has now cited new references. As will be shown, these references also share this flaw.

First, Terrell fails to teach or suggest that the porous medium is in contact with the solution. The Applicant strongly submits that the claim term “in contact” cannot be equated with “in contact, when inverted”. By way of example only, and for the Examiner’s convenient reflection, the phrases “the porous member is in contact with the solution” and “the solution is brought into contact with the porous member” do not have equivalent meanings.

Terrell does not teach or suggest that the scrubbing member 34 is in contact with the liquid. One skilled in the art would recognize the existence of the gap, or separation in space, between the scrubbing member 34 and the liquid in the liquid chamber 27. A person skilled in the art would also understand that Terrell describes a device that is intended to be used in the upright position. Terrell’s device has a base portion and an upper chamber 29, which essentially indicates the vertical orientation of the device. Terrell teaches:

With the structure 20 holding a supply of nail polish remover liquid in chamber 27 of the container base 21 the closed sealed device is inverted to permit the liquid to pass through the finger bore openings to saturate the sponge-like inner walls of the liners 43 with the polish removing liquid. The device 20 is then placed in the upright position and the cap 31 removed.

Terrell at col. 3, lines 33-39.

When the device taught in Terrell is in the upright position, the liquid is never in contact with the scrubbing member. The Examiner’s attention is now directed to Terrell’s other teachings:

Since it is desirable that only the surfaces of the finger bore openings be saturated with the cleaning liquid, the scrubbing member may be provided with upper and lower moisture impervious surface skins 71 which have holes aligned with the

finger bore openings and which otherwise prevent contact of the liquid with the sponge rubber scrubbing member.

Terrell at col. 4, lines 6-13.

Hence, a person skilled in the art would no doubt conclude that Terrell teaches a rudimentary means of delivering a part of the liquid to the scrubbing member, where the liquid is separated from the scrubbing member when the device is in use in the upright position. This scheme is similar to the previously distinguished spraying means available in the prior art, except that, instead of using pumps or spraying heads, Terrell discloses merely inverting and/or shaking the device.

In contrast, the claimed nail polish removing device has a container which defines a polish removing solution compartment in a bottom part thereof. The Examiner's attention is respectfully drawn to the fact that, in the claimed invention, the porous and pliable medium is disposed in the container above the solution compartment and in direct contact with the solution contained therein.

Given the significant differences between Terrell's teachings and the claimed invention, and in view of the disincentive to combine Terrell and Masterson, it is submitted that the above-identified claims are not an obvious combination of Terrell and Masterson. Therefore the Examiner's rejection is respectfully traversed and reconsideration of the matter is earnestly requested.

It is clearly noted that Masterson was cited to show "a fingernail and hand cleaning device having a container (12) with a side wall (fig. 1), wherein the side wall having (sic) an opening (24) for inserting the fingernail or hand to be cleanse[d]". Clearly, Masterson does not overcome the deficiencies of Terrell since Masterson does not suggest a porous and pliable medium as recited in the claims.

Claims 2 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terrell in view of Masterson and further in view of U.S. Patent No. 4,510,954 to Miller (“Miller”). Applicant respectfully traverses this rejection and requests reconsideration of the above-identified Claims.

Miller was cited to disclose “a fingernail polish remover (fig. 3) comprising a container (12) having an opening (26), [and] a ledge (32) disposed at the bottom of the opening.” Clearly, Miller does not overcome the deficiencies of Terrell and Masterson since Miller does not suggest a porous and pliable medium as recited in the claims. Further, it is noted that Miller fails to disclose an opening in a side wall of a nail polish removing device. Miller teaches an opening 26 in a top wall. Miller also teaches finger position platforms 32. In fact, the platform of Miller cannot be located at the bottom side of the opening, since the opening is disposed in the top wall. The Examiner’s attention is directed to Miller’s teachings: “Extending downward from the top of the fluid containing compartment or tank 18 on the side of the opening 26 opposite the lip 28 and brush 22 are finger positioning platforms 32.” Miller at col. 4, lines 63-66.

Therefore, it would not have been obvious to one of ordinary skill in the art to provide the platform 32 as taught by Miller (which platform 32 is located on the side of an opening 26 in a top wall of the container) at a bottom side of an opening 24 as taught by Masterson (which opening 24 is elliptical and disposed in the hemispherical portion of the upper housing 10).

It is respectfully submitted that the devices taught by Terrell, Masterson, and Miller are quite dissimilar in structure. Thus, Claims 2 and 14 cannot be an obvious combination of the above-identified references.

Claims 4 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terrell in view of Masterson and further in view of U.S. Patent No. 6,695,800 to Gary et al (“Gary”).

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Gary was cited to disclose a hand treatment device (fig. 10) comprising a non-skid means (234).

Very clearly, Gary does not overcome the shortcomings of Terrell and Masterson since Gary does not suggest a porous and pliable medium as recited in the claims.

The above rejections under 35 U.S.C § 103 do not support a conclusion of obviousness. Applicant respectfully requests that the obviousness rejections against the Claims on file be withdrawn.

Conclusion

Applicant believes this application is in condition for allowance. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

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/Toby H. Kusmer/

Toby H. Kusmer, Reg. No.: 26,418

28 State Street

Boston, Massachusetts 02109

Telephone: (617) 535-4004

Facsimile: (617) 535-3800

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